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OFFICE OF PETITIONS

In re Application of
James Tranquilla
Application No. 09/872,178
Filed: June 1, 2001
Attorney Docket Number: 11108/3
Title of Invention: Method of Reducing Carbon
Levels in Fly Ash

ON PETITION

This is a decision on the petition filed February 16, 2005, under 37 CFR 1.137(a) and in the alternative under 37 CFR 1.137 (b) to revive the above-identified application.

The petition to revive under 37 CFR § 1.137(a) is **DISMISSED**.

The petition to revive under 37 CFR § 1.137 (b) is **GRANTED**.

This above-identified application became abandoned for failure to timely file a proper reply to a non-final Office Action. The non-final Office Action was mailed on January 22, 2003 and set a three (3) month shortened statutory period for reply. No extensions of time were obtained under the provisions of 37 CFR §1.136(a). Accordingly, this application became abandoned on April 23, 2003. A Notice of Abandonment was mailed on August 19, 2003.

PETITION TO REVIVE UNDER 37 CFR § 1.137(a)

A grantable petition under 37 CFR § 1.137(a) must be accompanied by:

- (1) the required reply,¹
- (2) the petition fee,
- (3) a showing to the satisfaction of the Director that the entire delay in filing the

¹ In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and

- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

The instant petition lacks items (3).

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 37 CFR §1.137(a).

The Office may revive an abandoned application if the delay in responding to the relevant outstanding office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 CFR § 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" is applicable to ordinary human affairs, and requires no more greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case by case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2D 1130 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).² Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.³

Petitioner asserts the application was unavoidably delayed because petitioner thought the Province of New Brunswick, who retained a security interest in Assignee's business, was going to prosecute the above-identified patent application.

²See MPEP 711(c)(III)(c)(2) for a discussion of the requirements for a showing of unavoidable delay.

³Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Petitioner's argument has been considered but is not persuasive. To the extent, petitioner retains interest in the above-identified patent application, reliance on the Province of New Brunswick to prosecute does not equate to unavoidable delay. Office records show that the above-identified patent was assigned to EMR Microwave Technology Corporation (reel 011877/ frame 0957). Thus as the only assignee of record, petitioner is held to the responsibility to timely prosecute the application. The failure to ascertain whether the Province of New Brunswick intended to prosecute the application is not unavoidable.

Accordingly, petitioner has failed to provide sufficient arguments that warrant the finding of unavoidable delay within the meaning of 37 CFR 1.137(a).

Alternative Venue

In the alternative, petitioner has requested the above petition be treated under 37 CFR 1.137(b).

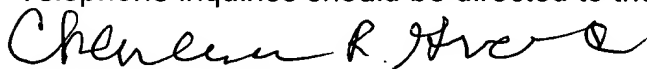
The statement of unintentional delay presented in the petition does not comply with the current rule. Pursuant to 37 CFR 1.137(b)(3) a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" is required. However, the statement presented will be accepted and construed as the statement required by 37 CFR 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The requirements for the filing of a grantable petition under 37 CFR §1.137(b) have been met. This Petition is hereby **Granted**.

Pursuant to petitioner's request deposit account 23-1925 will be charged the \$750.00 unintentional petition fee.

This application is being forwarded to Technology Center 1700 for further processing of the amendment submitted on February 16, 2005.

Telephone inquiries should be directed to the undersigned at (571) 272-3215.



Charlema R. Grant

Petitions Attorney

Office of Petitions